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David M. Allen

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EXAMINER

GILBERT, WILLIAM V

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DAVID M. ALLEN

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Appeal 2009-006936  
Application 10/694,304  
Technology Center 3600

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Decided: October 29, 2009

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Before JAMESON LEE, SALLY C. MEDLEY and  
MICHAEL P. TIERNEY, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION ON APPEAL

A. STATEMENT OF THE CASE

David M. Allen, (“Allen”), the real party in interest, seeks review under 35 U.S.C. § 134(a) of a Final Rejection of claims 1-13 and 16-18. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

References Relied on by the Examiner

Trutwin et al. (“Trutwin”)	6,202,380	Mar. 20, 2001
Pinto et al. (“Pinto”)	6,189,276	Feb. 20, 2001
Baum	1,585,960	May 25, 1926

Rejections on Appeal

The Examiner rejected claims 1-11, 13 and 16-18 as unpatentable under 35 U.S.C. § 103(a) over Trutwin and Baum.

The Examiner rejected claim 12 as unpatentable under 35 U.S.C. § 103(a) over Trutwin, Baum and Pinto.

All claims stand or fall together. Br. 3-6.

The Invention

Allen discloses, referring to Allen’s figure 5 reproduced below [numbers from figure 5 inserted], a baseboard assembly including a base portion [20] and a top portion [24]. An upper end [40] of the base portion [20] is sloped downwardly from the front surface [36] to the back surface [34]. A lower end [48] of the top portion [24] is sloped downwardly from the front surface [46] to the back surface [44]. The top portion [24] is to be installed with the sloped lower end [48] adjacent the sloped upper end [40] of the base portion [20]. Abs; Spec. pp. 2, 4.

Allen's figure 5 is below:

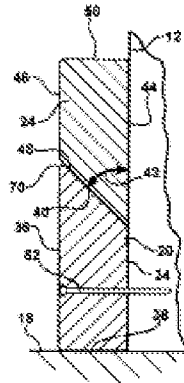


Figure 5 depicts a baseboard assembly.

Claim 1, reproduced from the Claims Appendix of the Appeal Brief, reads as follows:

A baseboard assembly installed in a junction region where a lower edge of a generally vertical wall meets a side edge of a generally horizontal floor, comprising:

a base portion having a back surface and an opposed front surface, the base portion further having a lower end and an upper end, the base portion being installed in the junction region with the back surface against the wall and the lower end adjacent the floor, the upper end of the base portion being sloped downwardly from the front surface to the back surface; and

a top portion having a back surface and an opposed front surface, the top portion further having a lower end and an upper end, the lower end of the top portion being sloped downwardly from the front surface to the back surface, the top portion being installed with the back surface adjacent the wall and the sloped lower end is adjacent the sloped upper end of the base portion;

wherein the base portion and top portion have dissimilar cross sections when taken perpendicular to the respective back surfaces.

Br. 8, Claims App'x.

B. ISSUE

Has Allen shown that the Examiner erred in determining that the claims would have been obvious based on the rationale provided by the Examiner?

C. FINDINGS OF FACT

Trutwin

1. Trutwin describes, referring to Trutwin's figure 2 reproduced below [numbers from the figure 2 inserted], a baseboard molding [10] including a top piece [11] including a bottom face [13], and a front face [14]; and a bottom piece [17] having a top [18]. Col. 4, l. 39-col. 5, l. 10.

Trutwin's figure 2 is below:

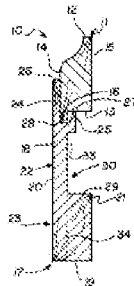


Figure 2 depicts a baseboard assembly.

2. The bottom face [13] of the top piece [11] has a downwardly extending tongue ridge [16] adjacent the front face [14] of the top piece [11]. Col. 5, ll. 2-4.
3. The top [18] of the bottom piece [17] has a spaced apart and generally parallel front and back extents [24], [25] defining a longitudinal groove [28]. Col. 5, ll. 11-20.
4. The tongue ridge [16] is inserted into the longitudinal groove [28] to join the top [11] and bottom [17] pieces together. Col. 5, ll. 21-23.

Baum

5. Baum describes, referring to Baum's figure 2 reproduced below [numbers from figure 2 inserted], a base-board [3] with a lower beveled surface [6] and a shoe mold [7] with an upper beveled surface. Col. 1, ll. 44-50.

Baum's figure 2 is below:

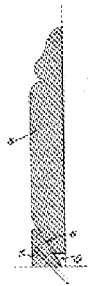


Figure 2 depicts a baseboard and shoe mold.

D. PRINCIPLES OF LAW

“A [prior art] reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect.” *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985) (emphasis omitted). The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned, as they are a part of the literature and relevant for all they contain. *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983), citing *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968).

It is not necessary to find precise teachings in the prior art directed to the specific subject matter claimed because inferences and creative steps that a person of ordinary skill in the art would employ can be taken into account. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

“[W]hen a[n] [application] claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR*, 550 U.S. at 416 (citing *U.S. v. Adams*, 383 U.S. 39, 50-51 (1966)).

Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, such a reconstruction is proper.

*In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

## E. ANALYSIS

### Claims 1-11, 13 and 16-18

Independent claim 1 is representative and recites (disputed limitations in *italics*): “a base portion . . . *the upper end of the base portion being sloped downwardly from the front surface to the back surface* . . . a top portion . . . *the lower end of the top portion being sloped downwardly from the front surface to the back surface* . . . *the sloped lower end is adjacent the sloped upper end of the base portion* . . . .” Br. 8, Claims App’x.

The Examiner finds that Trutwin describes the claimed limitations with the exception of a sloped juncture between the top [11] and bottom [17] pieces of the baseboard molding [10]. The Examiner relies on Baum to teach a baseboard with a juncture [6] that slopes from the front surface to the back surface. Final Rejection 3; Ans. 4. The Examiner determined that it would have been obvious to one with ordinary skill in the art to have the juncture in Trutwin slope as in Baum as a matter of functional equivalence

since the sloped juncture would perform equally as well as Trutwin's juncture.

Allen argues that the combination of Trutwin and Baum is not a mere substitution of one element for another since the element being substituted would necessarily have to be used in the same way as in the original reference. Br. 4-5. In connection with that argument, Allen argues that Baum's baseboard design is intended to reduce the stack-up between a shoe mold and baseboard by providing a beveled lower surface and nesting the shoe mold in the beveled area, leaving a gap. Br. 5. In other words, Allen asserts that Baum would have to be used the same way as it is described in Baum when combined with Trutwin.

Allen's arguments are misplaced because Allen focuses too narrowly on the teachings of Baum. The intended purpose of the Baum reference need not be preserved as Allen suggests. Rather, the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned, as they are part of the literature and relevant for all they contain. *Heck*, 699 F.2d at 1333, citing *Lemelson*, 397 F.2d at 1009.

Allen further argues that if Baum and Trutwin were combined by mere substitution, the combination would not provide sloped surfaces of upper and lower pieces and would not provide a predictable result. Br. 5. Allen argues that the logical and predictable combination would be to cut off the bottom of the lower portion of Trutwin's baseboard and use a nested shoe mold like Baum's shoe mold [7] thereby eliminating the use of a traditional shoe mold as would be used with Trutwin's baseboard. Br. 5.



The Examiner determined that replacing the Trutwin juncture with the Baum juncture [6] that slopes from the front surface to the back surface would result in the sloped surface(s) as claimed. That determination is reasonable. Allen has not directed us to objective evidence to demonstrate that the substitution of beveled joining surfaces described by Baum for Trutwin's joining surfaces [16], [28] would not yield a sloped engagement between the upper and lower portions of a baseboard as claimed.

The Examiner further determined that the combination would yield the predictable result of a two-piece trim member in which the upper portion is properly stabilized on the lower portion since both Baum and Trutwin describe junctures shaped to have a relatively higher front surface transitioning to a lower rear surface. Ans. 13. The Examiner's determination in this respect is also reasonable and Allen has not responded by way of a reply brief to demonstrate otherwise.

Lastly, Allen does not direct us to objective evidence to demonstrate that the logical and predictable combination would be to cut off the bottom of the lower portion of Trutwin's baseboard and use a nested shoe mold like Baum's shoe mold as asserted by Allen. Argument of counsel cannot take the place of evidence lacking in the record. *Meitzner v. Mindick*, 549 F.2d 775, 782 (CCPA 1977); *see also In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974). In addition, as already explained above, Allen is placing too much focus on preserving every aspect of the Baum reference. That focus is misplaced.

Allen further argues that Trutwin (1) does not provide a sufficient suggestion or motivation to combine the references in order to meet the claim limitations, and (2) does not provide the function and benefits of the

present invention. Br. 3 and 5-6. Allen's arguments are unpersuasive because it is not necessary to find precise teachings in the prior art directed to the specific subject matter claimed. Inferences and creative steps that a person of ordinary skill in the art would employ can be taken into account. *KSR*, 550 U.S. at 418.

Last, Allen argues that the Examiner has used the teachings of the present invention to combine features from the prior art. Br. 5. Any judgment of obviousness is in a sense necessarily a reconstruction based on hindsight. *McLaughlin*, 443 F.2d at 1395. Such a reconstruction is proper if it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure. *Id.* In this case, the determination of obviousness only takes into account knowledge which was within the level of ordinary skill at the time the invention was made; the knowledge and ordinary creativity of one skilled in the art to substitute beveled joining surfaces described by Baum for the joining surfaces [16], [28] of the baseboard top and bottom pieces [11], [17] of Trutwin. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR*, 550 U.S. at 421.

For all these reasons, Allen has not shown that the Examiner erred in determining that claims 1-11, 13 and 16-18 would have been obvious over Trutwin and Baum.

#### Claim 12

Allen does not argue the limitations of claim 12 separately. For the same reasons as those explained before, Allen has not shown that the

Examiner erred in determining that claim 12 would have been obvious over Trutwin, Baum and Pinto.

F. CONCLUSION

Allen has not shown that the Examiner erred in determining that the claims would have been obvious based on the rationale provided by the Examiner.

G. ORDER

The decision of the Examiner rejecting claims 1-11, 13 and 16-18 as unpatentable under 35 U.S.C. § 103(a) over Trutwin and Baum is affirmed.

The decision of the Examiner rejecting claim 12 as unpatentable under 35 U.S.C. § 103(a) over Trutwin, Baum and Pinto is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)

AFFIRMED

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